

RECEIVED  
CENTRAL FAX CENTER

JAN 19 2007

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0851-00xx  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE  
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>UNQA-0028</b>	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <b>01-19-2007</b> Signature <b>Robert Buckley</b> Typed or printed name <b>Robert Buckley</b>		Application Number <b>09/901,544</b> Filed <b>07-08-2001</b> First Named Inventor <b>Sharif</b> Art Unit <b>2673</b> Examiner <b>Dharia, Prabodh M.</b>	
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.  This request is being filed with a notice of appeal.  The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <b>33657</b> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		Signature <b>Robert Buckley</b> Typed or printed name <b>Robert Buckley</b> Telephone number <b>(925) 447-4990</b> Date <b>01-19-2007</b>	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

RECEIVED  
CENTRAL FAX CENTER

JAN 19 2007

Attorney's Docket No. UNIQA-0028

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

5 In re application of: Sharif et al.  
Serial No.: 09/901,544  
Filed: 07/08/2001  
For: " System and Method for Internet Appliance Data Entry  
and Navigation "

10 Group No.: 2673  
Examiner: Dharia, Prabodh M.

15 Via facsimile  
Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

20

## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

25 The applicants request a pre-appeal brief review of this application (OG Notices: 12  
July 2005). A Notice of Appeal and authorization to pay any necessary fees accompany  
this request.

30 **Status of Claims:** Claims 1 – 20 are pending, are rejected, and the rejections are  
appealed. Claim 1 is the only independent claim, claims 2 – 20 depend directly or indirectly  
from claim 1.

35 **PAIR References:** Applicants are unable to identify papers referred to by "Paper Number."  
All references made herein have the following format: "PAIR: PAIR-Date, generic title, page  
and line numbers if appropriate." PAIR references are incorporated by reference herein as  
though set forth *in haec verba*.

**Examination History:** Claim 1 was amended once (PAIR: 12-13-2004, Complete List of Claims, page 1) to overcome an art rejection following a first Office action (PAIR: 03-03-2004, Non-Final Office Action, page 3) and has not been further amended. Claim 17 was amended once (PAIR: 12-13-2004, Complete List of Claims, page 4) to correct claim  
5 dependency. Claims 2 – 16 and 18 – 20 have not been amended. The final rejections of all claims have been twice appealed (PAIR: 08-22-2005, Notice of Appeal, and 06-15-2006, Notice of Appeal), and now three times appealed. Following each of the first two appeals the examiner reissued a non-final Office action, withdrawing the grounds for rejection and stating new grounds (PAIR: 12-13-2005, Non-Final Rejection, and 07-31-2006, Non-Final  
10 Rejection, respectively). The examiner has now made the rejections of all claims final for a third time (PAIR: 12-04-2006, Final Rejection). The applicants have now appealed for a third time. New art cited but not relied upon by the examiner (PAIR: 12-04-2006, List of References Cited) in his most recent final rejection suggests that he is prepared to withdraw the grounds for rejection once again in response to an appeal.

15  
**Relief Sought:**

The applicants desire a patent that will stand up to scrutiny in the real world. They ask that a new examination take place based upon a new search that conforms with the high standards of the USPTO, or in the alternative that the present appeal be permitted to  
20 proceed to the Board.

**Summary of Claimed Subject Matter:**

The applicants incorporate the summary found in PAIR: 10-26-2006, Amendment after Non-Final Rejection, page 1, line 30 through page 2, line 10.

25  
**Grounds of Rejection**

The applicants incorporate the grounds found in PAIR: 12-04-2006, Final Rejection, page 2, heading numbered "3", page 5, heading numbered "4", and page 7, heading numbered "5".

**Remarks:**

A. With respect to the 103(a) rejection of the independent claim 1 over DeBoor et al. (US 6,675,204) in view of Krueger et al. (US 6,098,086), the examiner fails to establish a *prima facie* case for obviousness under 35 USC 103(a) in that the proposed modifications  
5 render the invention of the primary reference unsatisfactory for its intended purpose (MPEP §2143.01 subsection V). The applicants assert the following two grounds for their traversal of this rejection.

1. Claim 1 separates the source of a reduced keyset keystroke sequence from the set-top box. DeBoor et al. combine these functions within a single hand-held device. The  
10 proposed modification would separate the source of the keystroke sequence in DeBoor et al. from the remaining functions of the hand-held device (In support of this proposition, the applicant incorporates his remarks found at PAIR: 06-15-2006, Appeal Brief, page 3, line 29 through page 4, line 6, and continuing at page 4, line 24 through page 5, line 14).

2. Claim 1 provides a video output to a standard television set. DeBoor et al. utilize a cell-phone size display contained within the hand-held device. The proposed  
15 modification would add a video output to an ordinary television set to the hand-held device (In support of this proposition, the applicant incorporates his remarks found at PAIR: 10-26-2006, Amendment After Non-Final Rejection, page 2, line 26 through page  
20 4, line 13).

Doing either of these modifications renders the DeBoor et al. device unsatisfactory for its intended purpose within the meaning of MPEP §2143.01 subsection V. The  
25 examiner (PAIR: 12-04-2006, Final Rejection, page 9, heading numbered "7") relies upon *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981) for the proposition that the combined teaching of the references would have suggested the claimed subject matter to persons having an ordinary level of skill in the art. *Keller* is good law so far as it goes, but MPEP §2143.01 subsection V is good law too. The purpose of subsection V appears to be  
30 an effort to prevent hind-sight reconstruction of the claimed invention by finding its

elements in various prior art publications. Subsection V cautions that no motivation to modify exists when the proposed modifications render the primary reference unsuitable for its intended purpose, in the DeBoor et al. instance, a hand-held device. The examiner's sole reliance upon *Keller* appears to be misplaced.

5

Therefore, claim 1 is patentable over the cited references, and claims 2 – 20 are patentable because they depend directly or indirectly from claim 1.

10 B. Claims 7 – 9, 12 and 13 are patentable over De Boor (US 6,675,204 B2) in view of Krueger et al. (US 6,098,086) as applied to claims 1 – 6, 10, 11, 14 and 15 above, and further in view of Mankovitz (US 5,949,492) because these claims are directly or indirectly dependent upon the patentable claim 1.

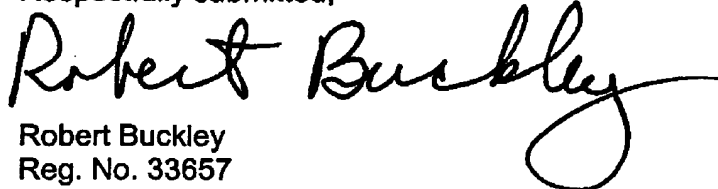
15 C. Claims 16 – 20 are patentable over De Boor et al. (US 6,675,204 B2) in view of Krueger et al. (US 6,098,086) as applied to claims 1 – 6, 10, 11, 14 and 15 above, and further in view of Yablon (US 5,764,731) because these claims are directly or indirectly dependent upon the patentable claim 1.

**Complete Listing of the Claims:**

20 The applicants incorporate the complete list of claims set forth in PAIR: 12-13-2004, Amendment after Non-Final Rejection – Complete Listing of Claims.

25

Respectfully submitted,

  
Robert Buckley  
Reg. No. 33657